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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,672	07/28/2003	Alan J. Schunemann	5363-001-23	4611

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EXAMINER

LIN, WEN TAI

ART UNIT PAPER NUMBER

2154

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,672

Applicant(s)

SCHUNEMANN, ALAN J.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/15/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-30 are presented for examination.
2. Claims 5, 28 and 30 are objected to because the following terms lack antecedent basis:

In claim 5, "said web server";

In claim 28, "said received internet protocol address"; and

In claim 30, "said received at least one of said fields of data".
3. It is noted that the "thereby" clauses contained in claims 1, 10 and 22 have been construed as "intended use" portions of their respective claims, therefore they are not positive limitations and can be rejected by a prior art which is inherently capable of performing the intended use (In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the

Art Unit: 2154

invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9-11, 13-18, 20, 22-23, 25-27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Judge et al.[U.S. PGPub 20030172167].

6. As to claim 1, Judge teaches the invention as claimed including: a system for identifying users of a plurality of computers within a communications network [e.g., Figs. 1-2], comprising:

a database [110, Fig.2] storing directory information for a plurality of users authorized to use the plurality of computers within the communications network [paragraphs 44-45; e.g., legitimate senders of emails are identifiable via the collected names whitelist];

a name discovery apparatus having at least one connection to a primary switch in the communications network for capturing inbound and outbound electronic mail traffic [paragraph 110]; and

a server, connected to said name discovery apparatus and having access to said database via the communications network, said server having a server process capable of joining said inbound and outbound electronic mail traffic captured by said name discovery apparatus and said directory information stored in said database, thereby identifying which of said plurality of users is using which of the plurality of computers [e.g., Fig.9; paragraphs 39, 41-42, 197, 210-214].

Art Unit: 2154

7. As to claims 2-3, Judge further teaches that the communications network is a local area network, which is an Ethernet network [150, 190, Fig.2].

8. As to claim 4, Judge further teaches that the communications network is a wide area network [160, Fig.2].

9. As to claim 5, Judge teaches that the system further comprising a central repository, accessible by said name discovery apparatus and said Web server, for storing said inbound and outbound electronic mail traffic captured by said name discovery apparatus [paragraphs 44-46].

10. As to claim 6, Judge does not specifically teach that said database is an ITU-T X.500 formatted database. However, since Judge does not limit its database to certain formats, it is obvious to one of ordinary skill in the art that Judge's system is open for different kind of database formats, such as ITU-TX.500, because the ability to be adaptive to different type of database formats enables Judge's system/method to be implemented in a wider variety of operating environments.

11. As to claim 7, Judge further teaches that said database contains at least the email addresses and IP-addresses relating to said plurality of users [paragraphs 210-214].

Art Unit: 2154

12. As to claim 9, Judge further teaches that said inbound and outbound electronic mail traffic captured by said name discovery apparatus includes at least one of the following: (i) POP electronic mail traffic; (ii) IMAP electronic mail traffic; and (iii) SMTP electronic mail traffic [e.g., paragraph 10].

13. As to claim 10, since the features of this claim can also be found in claims 1, it is rejected for the same reasons set forth in the rejection of claims 1 above.

14. As to claim 13, Judge further teaches that said extracting step comprises the step of: using pattern matching based upon a known electronic mail protocol to extract said Internet Protocol addresses and said electronic mail addresses from said captured inbound and outbound electronic mail traffic [e.g., paragraph 42].

15. As to claims 11, 14-18, 20, 22-23, 25-27 and 29, since the features of these claims can also be found in claims 1-4, 6-7, 9-10 and 13, they are rejected for the same reasons set forth in the rejection of claims 1-4, 6-7, 9-10 and 13 above.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

Art Unit: 2154

at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 8, 12, 19, 21, 24, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judge et al. (hereafter "Judge") [U.S. PGPub 20030172167], as applied to claims 1-7, 9-11, 13-18, 20, 22-23, 25-27 and 29 above.

18. As to claim 8, Judge does not specifically teach that said server process is a Web server process capable of responding to browser-based queries to identify which of the plurality of users using the plurality of computers,

However, Judge's system/method is situated in a client-server network environment, wherein a web server may responds to a user's request. Since Judge's system/method is also applicable to peer-to-peer communication environment [e.g., paragraph 42], and its legitimate users' information is stored as a "whitelist" in a database associated with a web server [110, Fig.2], it is obvious to one of ordinary skill in the art that Judge's system can be used for associating the online users with their computers because Judge's whitelist provides the real-time messages originating identities, such as IP addresses for further identifying the computers/devices they are using.

19. As to claims 12, 19, 21, 24, 28 and 30, since the features of these claims can also be found in claims 1, 8, 10-11, 20, 22-23 and 29, they are rejected for the same reasons set forth in the rejection of claims 1, 8, 10-11, 20, 22-23 and 29 above.

Art Unit: 2154

As to the additional limitations requiring the use of a predetermined time interval for accessing the central database (for identifying whether a user is using a computer connected to the network) in claims 12 and 24: it is noted that since Judge's system/method is also intended for identifying real-time messages originators, it is clear that there is also an inherent interval of time involving the validity of the collected email information for the purpose of real time usage.

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Bullard et al.	[U.S. Pat. No. 6405251];
Zoken	[U.S. Pat. No. 5944787];
McKinnon et al.	[U.S. PGPub 20040133641]; and
Campise et al.	[U.S. PGPub 20030200272].

21. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Art Unit: 2154

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

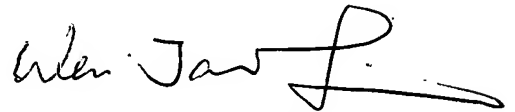
(571)273-3969 for status inquiries draft communication.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

March 15, 2005


3/15/05